

REMARKS

A Final Office Action was issued in this application on July 26, 2005. Applicant responded on October 25, 2005. An Advisory Action was mailed on December 5, 2005, indicating that applicant's response was not entered. This paper is submitted along with a Request for Continued Examination and (a) reiterates the amendments and remarks made in the October 25 response, and (b) responds to the points raised in the Advisory Action.

At the time the Final Office Action was mailed (July 26, 2005), claims 1, 3-6, 9-23, 27-29, 33-41, and 44-50 were pending in this application. Claims 1 and 18 have been amended, and new claims 51 and 52 have been added in this response. Accordingly, claims 1, 3-6, 9-23, 27-29, 33-41, and 44-52 are now pending.

In the Final Office Action, all the pending claims were rejected. More specifically, the status of the application in light of this Office Action is as follows:

(A) claims 1, 18 and their dependents stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement;

(B) claim 18 and its dependents stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite; and

(C) claims 1, 3-6, 9-17, 44 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,113,662 to Sprules ("Sprules").

The undersigned attorney wishes to thank the Examiner for engaging in a telephone interview on October 20, 2005. During the telephone interview, the pending claims, the foregoing rejections, and the applied reference were discussed. The following remarks summarize and expand upon the points discussed during the October 20 telephone interview.

A. Response to the Section 112, First Paragraph Rejections

Claims 1, 3-6, 9-23, 27-29, 33-41 and 44-50 were rejected in the Final Office Action under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Specifically, the Examiner asserted that the claim feature "substantially free of glass, metals, plastics, and paper" is not supported by the specification. In the response filed after the Final Office Action, the applicant attempted to amend claims 1 and 18 to replace the word "substantially" with "approximately or completely." In the subsequent Advisory Action, the Examiner refused to enter these amendments and noted that "the term 'approximately' is synonymous to 'substantially.'" The Examiner further asserted that "Applicant does not have support in the specification for either term." Claims 1 and 18 have been amended in the present communication without narrowing the scope of these claims to replace the word "substantially" with "approximately or completely." As discussed below, the present application as filed provides support for this claim feature and complies with the MPEP requirements on this point.

MPEP § 2163 states:

The first paragraph of 35 U.S.C. 112 requires that the 'specification shall contain a written description of the invention'. . . To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. . . . An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. . . . The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.

The text on page 7, lines 25-26, and page 8, lines 28-29 of the present application describes the "approximately or completely free of glass, metals, plastics, and paper" claim feature in sufficient detail that one skilled in the art can reasonably conclude that the

inventor had possession of the claimed invention. More specifically, the patent specification recites, "In addition, the municipal solid waste should be free of or have a low content of recyclable materials." (P. 8, Ins. 28-29.) Furthermore, the patent application recites, "It is understood that municipal solid waste would normally contain recyclable materials e.g. plastics, glass, aluminum, paper and other materials." (P. 7, Ins. 25-26.) Accordingly, the specification clearly describes that municipal solid waste can be free of or have a low content of plastics, glass, aluminum, and paper.

In the Final Office Action, the Examiner stated:

The specification states that . . . the municipal solid waste should be free of or have a low content of recyclable materials. The term 'low' as it refers to the amount of the recyclable material present in the solid waste does not particular[ly] point out how much of the solid waste material is recyclable materials. Is low 1%, 5%, 10%? The claimed language 'substantially free of' and 'have a low content' are not synonymous.

(Final Office Action, pp. 2-3.)

It appears the Examiner has misunderstood or misinterpreted the requirements of 35 U.S.C. § 112, first paragraph. With regard to the written description requirement, it is not relevant that "[t]he term 'low' as it refers to the amount of the recyclable material present in the solid waste does not particular[ly] point out how much of the solid waste material is recyclable materials." The written description requirement for the specification is different than the definiteness requirement for the claims. The relevant inquiry under the written description requirement is not whether one skilled in the art can associate an exact percentage with the word "low" in the specification. Rather, the proper inquiry under the written description requirement is whether one skilled in the art can reasonably conclude that the inventor had possession of the "approximately or completely free of glass, metals, plastics, and paper" claim feature based on the recitation of "free of or have a low content of plastics, glass, aluminum, and paper" in the specification.

One skilled in the art would conclude that the inventor had possession of this claim feature for the following reasons. First, the range defined by "free of or have a low content

of" includes the range defined by "approximately or completely free of." Therefore, the specification shows possession of the range set forth in the claim feature. Second, "low" is defined by The Concise Oxford Dictionary (Seventh Edition) as "of small or less than normal amount as measured by a scale or degrees." Clearly, municipal solid waste that has a low content or a less than normal amount of glass, metals, plastics, and paper is "approximately or completely free of glass, metals, plastics, and paper," and it would be so recognized by one skilled in the relevant art. Accordingly, one skilled in the relevant art would conclude that the inventor had possession of the "approximately or completely free of glass, metals, plastics, and paper" claim feature upon reading the specification. Furthermore, in light of the foregoing comments, claim 1 meets the requirements of Section 112, second paragraph because the claim particularly points out and distinctly claims the corresponding subject matter. Therefore, the Section 112 rejection of claims 1, 3-6, 9-23, 27-29, 33-41 and 44-50 should be withdrawn.

Claim 1 has been further amended, without narrowing the scope of the claim, to eliminate the phrase "in the form of a fluff." The Examiner agreed during the October 20 telephone interview that this amendment would not affect the patentability of claim 1 under Section 103, which is discussed further under Heading C below.

Claim 18 was further rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to support the phrase "before and/or after" in element (c) of the claim. Without commenting on or conceding the merits of this rejection, claim 18 has been amended to replace the phrase "before and/or after" with the word "after." The Examiner agreed during the October 20 telephone interview that this term is adequately supported by the specification. The Examiner also agreed that the term "before" is adequately supported by the specification. Accordingly, applicants have added new claim 51, which is identical to amended claim 18, except that the word "after" in element (c) has been replaced with the word "before." Accordingly, claim 51 also complies with Section 112 and should be in condition for allowance.

B. Response to the Section 112, Second Paragraph Rejection

Claim 18 and the claims depending therefrom were rejected under 35 U.S.C. § 112, second paragraph because element (b) of claim 18 allegedly did not clearly indicate how waste is treated in order to obtain a fluff. Element (b) of claim 18 has been amended without narrowing the scope of the claim to clarify that treating the waste forms a fluff. As agreed to by the Examiner during the October 20 telephone interview, the specification provides representative examples of treatments for forming a fluff. Such treatments can (but need not) include shredding or pulverizing a product (specification at page 8, lines 2 and 7). Accordingly, the Section 112, second paragraph rejection of claim 18 and its dependents should be withdrawn.

C. Response to the Section 103 Rejections

Claim 1, as amended, is directed to a combustible pellet having a fuel value of at least 10,000 BTU per pound. The pellet comprises a recyclable-free, hazardous waste-free municipal solid waste, and at least one waste substance having a fuel value of at least 10,000 BTU per pound. The recyclable-free, hazardous waste-free municipal solid waste is approximately or completely free of glass, metals, plastics, and paper.

Municipal waste is characterized in the present application as waste that "may contain a wide variety of waste or discarded material" (specification at page 7, lines 3-4). Such waste "may include biodegradable waste, non-biodegradable waste, ferrous materials, non-ferrous metals, paper or cardboard in a wide variety of forms, a wide range of plastics (some of which may contain traces of toxic metals used as catalysts, stabilizers or other additives), paints, varnishes and solvents, fabrics, wood products, glass, chemicals including medicines, pesticides and the like, solid waste of various types and a wide range of other materials" (specification at page 7, lines 3-10). The foregoing representative (e.g., non-exhaustive) characterization of municipal waste is consistent with the commonly accepted use of the term as referring to a solid waste stream generated by a typical municipality.

Sprules discloses a solid burnable fuel composition (e.g., a log) that contains a major proportion of spent dried coffee grounds. The fuel composition includes "at least 50% dried spent coffee grounds and a combustible wax which are mixed together and compressed into a suitable shape for combustion" (Sprules at Abstract, emphasis added). Sprules further teaches that it may be desirable to increase the proportion of the composition that includes coffee, stating that "a log containing 90% coffee and 10% wax provides slightly more flame output than a log containing 50% wood sawdust and 50% wax" (Sprules at column 5, lines 61-64). Sprules further states the desirability of a homogeneous coffee composition for use in his product. For example, Sprules states that "since coffee can be obtained in a relatively homogenous mixture from food processing establishments, it is less likely to contain impurities such as found in sawdust (e.g., dirt, rocks, and metals from bark, furniture finishing processes, saw mills). Consequently, less energy and capital are required to clean the material input stream." (Sprules at column 7, lines 30-35, emphasis added.)

Sprules not only fails to disclose or suggest a combustible pellet comprising "recyclable-free, hazardous waste-free municipal solid waste," but explicitly teaches away from such a composition. For example, Sprules specifically states that his composition includes "at least 50% dried spent coffee grounds." While the undersigned attorney is willing to concede that municipal solid waste may include at least some spent coffee grounds (dried or otherwise), it is unreasonable to believe that any municipal solid waste stream would include at least 50% dried spent coffee grounds, as is required by Sprules' teachings. Accordingly, one of ordinary skill in the relevant art would not be motivated by Sprules' disclosure to replace at least 50% dried spent coffee grounds with municipal solid waste, which would clearly contain less than 50% dried spent coffee grounds.

Furthermore, Sprules explicitly states the desirability of a "relatively homogenous mixture from food processing establishments" as forming the basis for his composition. Again, it is unreasonable to expect that one of ordinary skill in the relevant art, after reviewing Sprules' disclosure, would replace Sprules' "coffee . . . obtained in a relatively

homogenous mixture from food processing establishments" with "municipal solid waste," which includes non-coffee waste from many other establishments as well. Accordingly, the reliance on Sprules fails to establish a *prima facie* case of obviousness with respect to claim 1, and therefore the Section 103 rejection of claim 1 should be withdrawn.

Claims 3-6, 9-17, 44 and 45 all depend from claim 1. Accordingly, the Section 103 rejections of these claims should be withdrawn for the foregoing reasons and for the additional features of these claims.

D. New Claim 52

New claim 52 has, *inter alia*, features generally analogous to the features included in claim 1. Accordingly, new claim 52 is patentable over the applied art for at least the reasons discussed above with reference to claim 1 and for the additional features of claim 52.

E. Conclusion

In view of the foregoing, the pending claims comply with 35 U.S.C. § 112 and are patentable over the applied art. The applicant accordingly requests reconsideration of the application and a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned representative at (206) 359-6465.

Dated: December 23, 2005

Respectfully submitted,

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